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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/597,779	08/08/2006	Yuki Horii	P30415	6266
52123 7590 03/07/2011 GREENBLUM & BERNSTEIN, P.L.C. 1950 ROLAND CLARKE PLACE RESTON, VA 20191				
EXAMINER NELSON, CHRIS A				
ART UNIT		PAPER NUMBER		
2193				
NOTIFICATION DATE		DELIVERY MODE		
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary

Application No.

10/597,779

Applicant(s)

HORII ET AL.

Examiner

CHRIS NELSON

Art Unit

2193

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 August 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 08 August 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-945)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 11/15/2006, 12/13/2006
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 101

1. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

2. **Claim 18** is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter as follows. Claim 18 defines a program. However, while the preamble defines a program, the body of the claim lacks definite structure indicative of a physical apparatus for storing such program. Therefore, the claim as a whole appears to be nothing more than a "collection" of software elements, thus defining functional descriptive material per se absent of a media for storing such elements.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. **Claims 1-6, 8-9, 14, and 16-18** are rejected under 35 U.S.C. 102(b) as being anticipated by JP 2001-318793 (hereinafter, Norikazu). All citations from the Norikazu reference are from the translated detailed description, unless otherwise specified

Claims 1, 17, and 18

Norikazu discloses a program execution device that downloads and executes a program, said device comprising:

- a storage unit having an area for storing the downloaded program (paragraphs 7 and 18)

- a storage judgment unit operable to judge whether or not it is possible for each of plural programs, including a program to be downloaded, to be held in said storage unit, based on a specific priority assigned in advance to each of the programs (paragraphs 7, 11-13, and 23)

- a notification unit operable to notify a user of a message regarding treatment of the program judged by said storage judgment unit as being impossible to be held (paragraph 10)

- a storage processing unit operable to store, in said storage unit, the program to be downloaded which has been judged by said storage judgment unit as being possible to be held (paragraph 7)

- an execution unit operable to execute the program stored in said storage unit (paragraph 12).

Claim 2

Norikazu further discloses:

a capacity acquisition unit operable to acquire a storage capacity required for storing each of the plural programs and an available space in said storage unit (paragraphs 24-26)

wherein said storage judgment unit is operable to judge, based on the storage capacity and the available space acquired by said space acquisition unit, that a program with a high priority can be preferentially stored, as long as the storage space of one program or all of the plural programs to be stored does not exceed a capacity in said storage unit (paragraphs 24-26)

Claim 3

Norikazu further discloses:

a deletion unit operable to delete a program stored in said storage unit, the program having been judged by said storage judgment unit as being impossible to be held (paragraphs 33-35)

wherein said notification unit is operable to notify the user of a message regarding the deletion of the program (paragraphs 37-38)

said storage processing unit is operable to store, in the storage unit from which the program has been deleted, the program to be downloaded that has been judged by said storage judgment unit as being possible to be held (paragraphs 39-40)

Claim 4

Norikazu further discloses:

wherein said deletion unit is operable to delete the program stored in said storage unit after detecting that the user has been notified by said notification unit (paragraphs 39-40)

Claim 5

Norikazu further discloses:

wherein said notification unit is operable to notify the user of a message requesting the user to confirm the deletion of the program stored in said storage unit (paragraphs 39-40)

said program execution device further comprises a confirmation acquisition unit operable to acquire a result of a confirmation which the user has made in response to the message (paragraphs 39-40)

wherein said deletion unit is operable to delete the program stored in said storage unit upon detecting that said confirmation acquisition unit has acquired the result of the confirmation (paragraphs 39-40)

Claim 6

Norikazu further discloses:

wherein said notification unit is operable to notify the user of a message inquiring whether or not it is acceptable to delete the program stored in said storage unit (paragraphs 39-40)

said program execution device further comprises an answer acquisition unit operable to acquire a result of an answer which the user has made in response to the message (paragraphs 39-40)

wherein said deletion unit is operable to delete the program stored in said storage unit upon detecting that the result of the answer acquired by said answer acquisition unit indicates that deletion has been allowed (paragraphs 39-40)

Claim 8

Norikazu further discloses:

wherein said storage judgment unit is further operable to judge whether or not the plural programs judged as being impossible to be held are stored in said storage unit (paragraph 30, identification information)

said notification unit is operable to notify the user of a message prompting selection of which program, from among the plural programs judged to be stored by said storage judgment unit, to delete (paragraph 39)

said program execution device further comprises a selection result acquisition unit operable to acquire a result of the selection made by the user in response to the message (paragraph 7)

wherein said deletion unit is operable to delete the program indicated by the result of the selection acquired by said selection result acquisition unit (paragraph 40)

Claim 9

Norikazu further discloses:

wherein said notification unit is operable to display the message to the user by using the program stored in said storage unit (paragraph 37)

Claim 14

Norikazu further discloses:

wherein said notification unit is operable to notify the user of a message regarding storage of the program to be downloaded that has been judged by said storage judgment unit as being impossible to be held (paragraphs 37-38)

Claim 16

Norikazu further discloses:

wherein said storage judgment unit is operable to judge whether or not to store, in said storage unit, each of plural programs that are of types differing from one another (paragraph 46). The programs would have inherently been of a different type if their priorities were different.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. **Claim 7** are rejected under 35 U.S.C. 103(a) as being unpatentable over Norikazu in view of US 2005/0129042 A1 (hereinafter, Muhonen).

Claim 7

Norikazu discloses the program execution device according to claim 6. Norikazu does not disclose changing the priority of a program based upon a user refusing to delete the program. However, the examiner maintains that it was well known in the art at the time of the invention to do so, as taught by Muhonen.

Muhonen discloses a priority change unit operable to raise the priority of the program stored in said storage unit (paragraph 73, "additionally or alternatively, the parameters can be associated with the respective piece(s) of content, or associated parameters can be deleted, modified, or the like at the content source and/or terminal, such based upon user input), the program having been judged by said storage judgment unit as being impossible to be held, upon detecting that the result of the answer acquired by said answer acquisition unit indicates that deletion has been rejected (paragraph 64)

wherein said storage judgment unit is operable to judge, again, whether or not it is possible to hold each of the programs in said storage unit, based on the priority changed by said priority change unit (paragraph 10)

It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the user interaction and parameter control of Muhonen with the user input for deletions disclosed by Norikazu. A user inclined to refuse deletion of content would have been motivated to change content's parameters so that it would not be a prospect for deletion during the next iteration. The purpose for doing so would have been to allow greater user control over deletions.

7. **Claims 10-13** are rejected under 35 U.S.C. 103(a) as being unpatentable over Norikazu in view of JP 2002-351680 (hereinafter, Akira). All citations from the Akira reference are from the translated detailed description, unless otherwise specified

Claim 10-13

Norikazu discloses the program execution device according to claim 10. Norikazu does not disclose determining if a program is currently being executed and stopping execution before deleting the program. However, the examiner maintains that it was well known in the art at the time of the invention to do so, as taught by Akira.

Claim 10: Akira discloses an execution judgment unit operable to judge whether or not the program, which has been judged by said storage judgment unit as being impossible to be held, is being executed by said execution unit (paragraph 8, application state acquisition means)

wherein said notification unit is operable to notify the user of a message regarding deletion of the program judged by said execution judgment unit as being executed (See claim 3 for analysis of Norikazu's user interaction during deletion).

Claim 11: wherein said deletion unit is operable to terminate execution of the program judged by said execution judgment unit as being executed, and to delete the program (paragraph 8)

Claim 12: wherein said notification unit is operable to notify the user of a message inquiring whether or not it is acceptable to delete the program judged by said execution judgment unit as being executed (See claim 3 for analysis of Norikazu's user interaction during deletion).

said program execution device further comprises an answer acquisition unit operable to acquire a result of an answer which the user has made in response to the message (See claim 3 for analysis of Norikazu's user interaction during deletion).

said deletion unit is operable to terminate and delete the program being executed, upon detecting that the result of the answer acquired by said answer acquisition unit indicates that deletion has been allowed (paragraph 8)

Claim 13: wherein upon detecting that the program being executed has been terminated based on a result of the judgment carried out by said execution judgment unit, said deletion unit is operable to delete the program (paragraph 8)

It would have been obvious to one of ordinary skill in the art at the time of the invention to stop an executing program and then delete it, using the user notifications of

Norikazu to ensure the user approves of the deletion. The purpose for doing so would have been to clear space that is otherwise inaccessible (see Akira paragraph 20)

8. **Claim 15** is rejected under 35 U.S.C. 103(a) as being unpatentable over Norikazu in view of 2002-335186 (hereinafter, Manabu). All citations from the Manabu reference are from the translated detailed description, unless otherwise specified

Claim 15

Norikazu discloses the program execution device according to claim 10. Norikazu does not disclose storing a plurality of programs at the same time or judging if it is possible to store a plurality of programs simultaneously. However, the examiner maintains that it was well known in the art at the time of the invention to do so, as taught by Manabu)

wherein said storage judgment unit is further operable to judge whether or not the plural programs judged as being impossible to be held are stored in said storage unit (paragraphs 106-108)

said notification unit is operable to notify the user of a message prompting selection of which program to store, from among the plural programs judged not to be stored by said storage judgment unit (See claims 1 and 14 for analysis of user interaction)

said program execution device further comprises a selection result acquisition unit operable to acquire a result of the selection made by the user in response to the message (See claims 1 and 14 for analysis of user interaction)

wherein said deletion unit is operable to store the program indicated in the result of the selection acquired by said selection result acquisition unit (paragraphs 106-108)

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to allow storage of multiple programs at the same time, and to keep the user interaction of Norikazu to determine which programs are stored in the event that there is not space for all programs. The purpose for doing so would have been to only require the user to give feedback once and therefore speed up storage of new programs.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to CHRIS NELSON whose telephone number is (571)270-7256. The examiner can normally be reached on Monday to Thursday, 9AM to 5PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lewis Bullock can be reached on (571)272-3759. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/CHRIS NELSON/
Examiner, Art Unit 2193

/Lewis A. Bullock, Jr./
Supervisory Patent Examiner, Art Unit 2193